

REMARKS

Reconsideration of the above-identified application in view of the foregoing amendments and following remarks is respectfully requested.

A. Status of the Claims and Explanation of Amendments

Claims 1-20 were pending, and were rejected in the pending office action. By this paper, the specification and claims 1, 3-4, 17 and 18 are amended, and new claims 21-23 are added.

The specification is amended to avoid non-idiomatic spellings (e.g., “colour” changed to “color”). In addition, the word “embossing” is changed to “granulating” in claims 3 and 4. Similar amendments are made throughout the specification. This was to correct a mistranslation of the French word “grainage.” These amendments are not made for any substantial reason related to patentability (§§ 102, 103).

Claims 1 and 17-18 had been objected to because the word “realizing” was found to be non-idiomatic and suggested to the examiner reference to a thought process. [12/6/05 Office Action at p. 2]. By this paper, claims 1 are amended to recite “creating” instead of realizing. A similar amendment is made to claim 17. As to claim 18, the examiner found disagreement between the term “surface” (singular) and the verb “are” (plural). [12/6/05 Office Action at p. 2]. The word “are” is now changed to “is.” These amendments are not made for any substantial reason related to patentability (§§ 102,

103), but are believed to resolve the objections to the claims. Withdrawal of the objections is respectfully requested.

Several rejection were rejected pursuant to 35 U.S.C. § 112, ¶2 for alleged indefiniteness. Claims 1 and 17 were said to be unclear because of the phrase “indicating device.” [12/6/05 Office Action at p. 2]. By this paper, claims 1 and 17 are amended to recite that the component is “configured to emit a light beam.” These amendments are not made for any substantial reason related to patentability (§§ 102, 103). As is well known in this industry, a lighting device emits light to improve visibility of the driver. Exemplary lighting devices include high beam headlights, low beam headlights and anti-fog beams. An indicating device is intended to be seen by the drivers of other vehicles. Exemplary indicating devices are front and rear turn signals, braking or stop lights, fog rearlamps, and daytime running lights. Applicants request consideration and withdrawal of this rejection as one of ordinary skill in the art would fully understand and appreciate the scope of the pending claims.

Claim 2 is said to be indefinite because the examiner is unsure when the metallization is to occur. [12/6/05 Office Action at pp. 2-3]. Likewise, claims 2-4 and 18 also were rejected pursuant to 35 U.S.C. § 112, ¶1 for lack of enablement because the specification was asserted not to disclose simultaneous metallizaing and laser radiation. [12/6/05 Office Action at p. 3]. Without commenting on the accuracy of the examiner’s assertion, claim 2 is amended to recite the metallization step occurs “before or after laser radiation exposure.” These amendments are not made for any substantial reason related to

patentability (§§ 102, 103). This claims is asserted to definite and properly enabled by Applicants' specification. See, e.g., page 3, lines 6-11. Withdrawal of these rejections is requested.

Claim 1 is further amended to recite that the step of forming "a mask or a reflector" for said component. Support for this claim amendment is found throughout the application as originally filed, including for example at page 5, lines 1-3 and 15-30.

New claim 21, dependent from claim 1, recites "the laser radiation exposure step provides a optically transparent light window in said mask which is otherwise opaque." New claim 22, also dependent from claim 1, recites "the laser radiation exposure step provides a matt zone of lesser reflection in said mask or in said reflector that a remainder of said mask or said reflector." New claim 23 is independent and is directed to a method "comprising: providing a pair of motor vehicle headlamp reflectors using a single mould; and selectively exposing the pair of reflectors to laser radiation to differentiate a one of the pair for use as in a right-hand headlamp and a second of the pair for use in a left-hand headlamp." Support for these new claims is found throughout the application as originally filed including for example at page 3, lines 25-29, page 5, lines 15-30, and Figures 2 and 3 (as well as their associated text).

No new mater will be added to this application by entry of these amendments. Entry is respectfully requested.

The six rejections on the merits stated in the office action were:

- Claims 1-2, 5-6, and 17-20 were rejected pursuant to 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,817,243 to Shaffer et al. ("Shaffer") [12/6/05 Office Action at pp. 5-6].
- Claims 1, 6 and 17-18 were rejected pursuant to 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,614,338 to Pyburn et al. ("Pyburn"). [12/6/05 Office Action at p. 6].
- Claims 1-2, 5-6 and 17-20 were rejected pursuant to 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,911,317 to Tsai ("Tsai") in view of Pyburn. [12/10/05 Office Action at pp. 6-7].
- Claims 1-2, 5-6, and 17-20 were rejected pursuant to 35 U.S.C. § 102(b) as allegedly being anticipated by Japanese Patent Publication No. 2000-176659 to Shizuku Hideji ("Hideji") [12/10/05 Office Action at p. 7].
- Claims 3-4 were rejected pursuant to 35 U.S.C. § 103(a) as allegedly being unpatentable over Shaffer in view of Great Britain Patent No. 2,244,934 to Pope ("Pope") or U.S. Patent Publication 2004/0145289 to Ouderkirk et al. ("Ouderkirk"). [12/10/05 Office Action at pp. 7-8].
- Claims 3-4 were rejected pursuant to 35 U.S.C. § 103(a) as allegedly being unpatentable over Hodeji or Tsai in view of Pyburn and U.S. Patent Publication No. 2001/0019013 to Weber et al. ("Weber"). [12/10/05 Office Action at p. 8-9].

With specific regard to the rejections based upon the Ouderkirk reference,

Applicants submit that this reference is not prior art under any provision of 35 U.S.C.

§ 102. Ouderkirk was published July 29, 2004 on an application filed December 2, 2003.

Ouderkirk claims priority to provisional patent applications filed January 27, 2003. The present application has a U.S. filing date of December 4, 2003 and claims priority

pursuant to 35 U.S.C. § 119 to a French patent application filed December 5, 2002, and antedates Ouderkirk. Withdrawal of the rejections based on Ouderkirk is requested.

In addition, there was a provisional obviousness-type double patenting rejection of claims 1-2, 5-6 and 17-20 over claims 1-2, 4-5 and 11-14 of Application Serial No. 10/729,305 (“the ‘305 application”). Withdrawal of the obviousness-type double patenting rejection over Appl. 10/729,305 (“the ‘305 application”) is requested. Applicants note that the filing dates of these applications are the same:

	<u>Appl. 10/729,184</u>	<u>Appl. 10/729,305</u>
U.S. Filing Date:	12-04-2003	12-04-2003
Priority Application:	FR 02 15 673	FR 02 15 674
Priority Date:	12-05-2002	12-05-2002

Accordingly, the ‘305 application is not prior art to the present application and cannot properly be cited in a double patenting rejection. Moreover, Applicants understand that there are no allowable claims either this application or the ‘305 application at this time. This rejection is respectfully requested to be held in abeyance until such time as that occurs.

B. Claims 1-6 and 17-20 are Patentably Distinct from the Cited References

The rejection on the merits are traversed since the seven cited-references (Shaffer, Pyburn, Tsai, Hideji, Pope, Ouderkirk and Weber) taken alone or in combination fail to teach disclose or suggest all of the features of Applicant’s claims.

Applicant's claim 1 recites:

1. A method of creating an optical function on a component of a motor vehicle indicating or lighting device configured to emit a light beam, comprising:

forming a mask or a reflector for said component in a predetermined material; and

exposing at least one surface of said component to laser radiation.

Shaffer is directed to a method for applying decorative contrast designs to automotive and motorcycle parts using lasers. Specifically, a laser (1) is used to etch "permanent decorative contrast design 12" into a part (11). [Shaffer, Col. 1, lines 36-45 and Col. 2, lines 47-57]. Shaffer's laser etching, however, is described as not altering the characteristics of the plastic parts that have been etched:

"When the part material is plastic (such as for a clear or colored light lens or globe), the laser etch may desirably leave etched areas opaque to enhance the overall decorative contrast of the design, both when light is and is not directed through the part. Further, the laser may be set to affect the plastic between the front and back surfaces of the part. In other words the beam may be focused to a point within the plastic part. In this way, the image is formed by affecting, such as by discoloring, portions of the plastic within the part. This is highly desirable, since it has been discovered that when the image is transferred to a spot within the part, the plastic globe or lens so marked will not adversely affect transmission of a light beam through the plastic globe or lens." [Shaffer, Col. 5, lines 10-14].

Moreover, the parts may be comprised of "metals, plated metals, plastics, mirrored glass and leather." [Shaffer, Col. 4, lines 43-45]. Plastic parts described are "transparent or translucent lenses for automobile or motorcycle light globes and lenses" which are "particularly preferred. [Shaffer, Col. 4, lines 51-53]. Shaffer's example 3

describes “Laser Decorating Plastic” and involves laser etching of a design into a polycarbonate plastic lens to provide a “dark contrasting image” when light was directed to the plastic. [Shaffer, Col. 7, lines 25-40].

Thus, Shaffer fails to teach, disclose or suggest “forming a mask or a reflector for said component in a predetermined material” as recited in Applicants’ claim 1.

Pyburn is directed to a process for manufacturing backlit displays utilizing treated plastics and laser energy. Pyburn is directed to the manufacture of components such as buttons using in illuminated graphic displays which can serve an interior controls. [Pyburn, Col. 3, lines 61-66]. Pyburn describes that a plastic button (10) includes a dispersion of pigment. [Pyburn, Col. 4, lines 20-32]. Upon exposure to laser energy, the button is locally overheated and becomes substantially optically opaque in predetermined areas. [Pyburn, Col. 4, lines 32-35]. This is said to permit graphic images (18) to be generated on the button (10). [Pyburn, Col. 4, lines 46-50; Figure 2]. Thus, Pyburn fails to teach, disclose or suggest “forming a mask or a reflector for said component in a predetermined material” as recited in Applicants’ claim 1.

Tsai is directed to light permeable metal plated rubber key. A light permeable metal plated key is formed from a base part (1) made of silicone rubber, which is sprayed or printed with a light permeable ink (2), applied with a protective layer (3), plated with a metal film (4) and laser engraved to display the required letter, and then applied with a second protective layer (6). [Tsai, Col. 2, lines 9-29]. Thus, Tsai fails to

teach, disclose or suggest “forming a mask or a reflector for said component in a predetermined material” as recited in Applicants’ claim 1.

Hideji is directed to transparent material processing for button and name plates involving thermocompression bonding of metallic foil to a transparent base.

Again, Hideki fails to teach, disclose or suggest “forming a mask or a reflector for said component in a predetermined material” as recited in Applicants’ claim 1.

Several additional references (Pope, Ouderkirk, Weber) were cited in the office action as allegedly disclosing features recited in dependent claims 3 and 4.

Without commenting on those assertions, we note that each of these references also fails to teach, disclose or suggest “forming a mask or a reflector for said component in a predetermined material” as recited in Applicants’ claim 1. Pope is directed to a dart flight, Ouderkirk is directed to phosphor based light sources, and Weber is directed to electrical switch assembly for a motor vehicle with separate icon display. Indeed, Applicants further submit that each of these references constitutes nonanalogous art, which may not be cited against the patent claims in a Section 103 rejection. See MPEP § 2141.01(a). For example, we fail to see how a dart flight could be fairly described to be within the present inventors’ field of endeavor, or reasonably pertinent to the particular problem with which the inventor was involved. *See In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992).

Accordingly, as Applicants cannot find the forming step of claim 1 in the cited references, at least independent claims 1 and 17, and their dependent claims 2-6 and

18-22 are respectfully asserted to be in condition for allowance. Also, independent claim 23 is patentably distinct from these references for at least similar reasons.

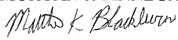
Applicants have chosen in the interest of expediting prosecution of this patent application to distinguish the cited documents from the pending claims as set forth above. These statements should not be regarded in any way as admissions that the cited documents are, in fact, prior art. Finally, Applicants have not specifically addressed the rejections of the dependent claims. Applicants respectfully submit that the independent claims, from which they depend, are in condition for allowance as set forth above. Accordingly, the dependent claims also are in condition for allowance. Applicants, however, reserve the right to address such rejections of the dependent claims in the future as appropriate.

CONCLUSION

For the above-stated reasons, this application is respectfully asserted to be in condition for allowance. An early and favorable examination on the merits is requested. In the event that a telephone conference would facilitate the examination of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY ADDITIONAL FEES WHICH MAY BE REQUIRED FOR THE TIMELY CONSIDERATION OF THIS AMENDMENT UNDER 37 C.F.R. §§ 1.16 AND 1.17, OR CREDIT ANY OVERPAYMENT TO DEPOSIT ACCOUNT NO. 13-4500, ORDER NO. 1948-4826.

Dated: June 6, 2006

Respectfully submitted,
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. : 10/729,184 Confirmation : 2383
Applicant(s) : Ghislain LEFEVRE et al.
Filed : December 4, 2003
Title : METHOD OF REALIZAING AN OPTICAL FUNCTION ON A
COMPONENT OF A MOTOR VEHICLE INDICATING OR LIGHTING
DEVICE
Art Unit : 1762
Examiner : Marianne L. FADGETT

Docket No. : 1948-4826
Customer No. : 27123

AMENDMENT FEE TRANSMITTAL

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is an Amendment for the above-identified application.

- ☐ No additional fee is required.
☒ The additional fee has been calculated as shown below:


CLAIMS AS AMENDED

	Claims Remaining After Amendment	Highest No. Covered by Previous Payments	Extra	Rate	Additional Fee
Total Claims*	23	20	3	\$50.00/ \$25.00	\$ 150.00
Independent Claims	3	3	0	\$200.00/ \$100.00	\$ 0
Multiple Dependent Claims	(If claims added by amendment include Multiple Dependent Claim(s) and there was no Multiple Dependent Claim(s) in application before amendment add \$360.00 to additional fee (\$180.00 for small entity).				\$ 0
TOTAL					\$ 150.00

*Includes all independent and single dependent claims and all claims referred to in multiple dependent claims. See 37 C.F.R. §1.75(c).

- ☐ Small entity status is or has been claimed.
Reduced Fees Under 37 C.F.R. §1.9(f) paid herewith \$ _____
- ☐ _____ Pages Sequence Listing
- ☐ _____ Computer disk(s) containing substitute Sequence Listing
- ☐ Statement under 37 C.F.R. §1.825(b) that the computer and paper copies of the substitute Sequence Listing are the same.
- ☐ A check in the amount of \$ _____ to cover the filing fee is attached.
- ☒ Charge fee to Deposit Account No. **13-4500**, Order No. **1948-4826**. A DUPLICATE COPY OF THIS SHEET IS ATTACHED.
- ☒ The Commissioner is hereby authorized to charge any additional fees which may be required for filing this amendment, including all fees pursuant to 37 CFR §1.17 for its timely consideration, or credit any overpayment to Deposit Account No. **13-4500**, Order No. **1948-4826**. A DUPLICATE COPY OF THIS SHEET IS ATTACHED.

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- ☒ Charge fee to Deposit Account No. **13-4500**, Order No. **1948-4826**. A DUPLICATE COPY OF THIS SHEET IS ATTACHED.
- ☒ The Commissioner is hereby authorized to charge any additional fees which may be required for filing this amendment, including all fees pursuant to 37 CFR §1.17 for its timely consideration, or credit any overpayment to Deposit Account No. **13-4500**, Order No. **1948-4826**. A DUPLICATE COPY OF THIS SHEET IS ATTACHED.

Dated: June 6, 2006

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